

ESTTA Tracking number: **ESTTA470231**

Filing date: **05/01/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Xylem Group, LLC		
Entity	Corporation	Citizenship	Georgia
Address	205 Hembree Park Dr. Ste. 130 Roswell, GA 30076 UNITED STATES		

Attorney information	James M. Slattery Birch Stewart Kolasch & Birch 8110 Gatehouse Rd. Ste. 100 East Falls Church, VA 30076 UNITED STATES jms@bkb.com, mailroom@bskb.com, johnst@bskb.com, bg@bskb.com Phone: 703-205-8000
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Applicant Information

Application No	85386849	Publication date	04/10/2012
Opposition Filing Date	05/01/2012	Opposition Period Ends	05/10/2012
Applicant	XYLEM IP HOLDINGS LLC 1209 ORANGE STREET WILMINGTON, DE 19801 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. All goods and services in the class are opposed, namely: Calibration, buffer, and electrolyte solutions for calibrating measuring and analyzing devices, except medical and veterinary devices
Class 006. All goods and services in the class are opposed, namely: Metal manually operated check valves; metal manually operated air charger and tank drainer valves; ring shaped boiler and expansion tank fittings of metal for hot water heating systems each including separate air and water passages; automatic and manual metal air vent covers for hot water heating and cooling systems, metal pipe fittings for branch flow circuitry from a main pipe circuit; manually operated metal shutoff and throttling valves with flow measuring capabilities and tank fittings; manually operated metal flow control valves, pressure reducing valves, pressure relief valves, dual unit valves consisting of pressure reducing and pressure relief valves, water mixing valves, check valves pressure actuated to close and gravity actuated to open, valves for use with water heating coils arranged to reverse the flow through and backwash the coils when the faucet is opened, metal pipe fittings for hot water heating systems
Class 007. All goods and services in the class are opposed, namely: Pumps, namely, centrifugal pumps, positive displacement pumps, gear pumps, submersible pumps and pump motors, flexible impeller pumps, vane pumps, macerator pumps, bilge pumps, live well/aerator pumps, engine cooling pumps, oil drain

pumps, diaphragm pumps, solids handling pumps, vacuum pumps, split case pumps, self-priming pumps, sludge pumps, process pumps, stock pumps, magnetic drive pumps, fire pumps, boiler feed pumps, peripheral pumps, drum pumps, close-coupled pumps, surface irrigation pumps, circulating pumps, booster pumps, machine pumps, airlift pumps, water pumps for pools, spas, whirlpools, wastewater treatment applications, heating, cooling, ventilation, and air conditioning applications, and general domestic, commercial, agricultural, marine, and industrial uses, and related parts, fittings, and accessories, namely, shafts for pumps, pump motor couplings, pump and pump motor bearings, pump seals, gaskets for pumps, pump lantern rings, pump impellers; Submersible mixers for general dewatering, flood control, waste handling, sewage disposal systems and flow generation; Blowers for marine vessels; Steam and hydronic machine parts, namely, steam traps, float traps, bucket traps, temperature control traps, and thermostatic traps; venting, steam, water supply, and tempering valves as machine parts; pneumatic, temperature, and pressure pilots as machine parts; pressure and temperature regulators as machine parts; strainers and vacuum breakers as machine parts; and surface condensers; Small commercial and residential pumping systems, namely, liquid pumps, piping, valves, pressure gauges, pressure switches, timers, relays and electrical switchgear, all mounted as a unit on a steel base, used for turf irrigation, providing variable flows of water at constant pressure; Condensate units comprising - centrifugal pumps, steel receivers, float switches, control panels, water level gauges, thermometers, inlet strainers, butterfly valves, manual alternators, pressure gauges, all sold as a unit; oil coolers for cooling quenching oil; machines, namely, plow blenders for wastewater sludge treatment, and parts and structural components therefore; sanitary pumps for pumping food products, namely, flexible impeller, rotary lobe and air operated diaphragm type pumps all of which are used to pump food products including beverages and other liquefied food stuffs

Class 009.

All goods and services in the class are opposed, namely: Microprocessor based pump controllers; Flow meters, flow meter systems including a balancing valve for HVAC fluid systems; Safety controls and valves, namely, boiler water feeders to safeguard steam and hot water boilers against the hazards of low water conditions, automatic automotive feeder cut-off combination valves, automatic float operated valves, liquid flow switches, liquid level controls, low water cut-offs, make up water feeder to insure an adequate supply of water for boiler demand, pressure relief valves to safeguard steam and hot water boilers against the hazards of low water conditions, proportioning regulators, pump controllers sequencing blow down valves, and replacement head mechanisms for feeders, cut-offs and pump controllers; electrical switches, namely, flow switches, float operated switches and snap switches; Instrumentation for monitoring and controlling water and wastewater treatment processes, namely, electronic, mechanical, and pneumatic control panels, controllers, transmitters, gauges, receivers, tables, samplers, regulators, rate set stations, indicators, turbidimeters, ph meters, consoles, consolettes, programmable logic controllers, programmers, power supplies, cables, computers, monitors, printers, electric valve actuators, data recorders, ultrasonic flow transmitters, autodialers, venturi flow elements, permutubes, insert tubes, flumes, and parts and components therefore all sold as a unit; Electrical and optical measurement, measuring, signal and monitoring apparatus and instruments, namely, temperature indicators, acid hydrometers, barometers, measuring apparatus for temperature and humidity levels in gases and solid substances, vibration meters, sound level meters, gas detectors for detecting the presence of carbon monoxide, carbon dioxide, nitrogen, nitrogen oxide, and ethylene gases, voltmeters, resistance measuring instruments, frequency meters, accelerometers, ammeters, anemometer, apparatus for testing gas, liquids and solids, automatic fluid-composition control machines and instruments, barometers, calorimeters, concentration meters, densimeters, electric meters, flowmeters, food timers, gas sensors for measuring gas concentration, hygrometers, liquid analyzers, pressure recorders, pyrometers, salinometers, speedometers, temperature sensors, thermistors, viscosimeters, electric meters and timers for testing oil and fat quality; vacuum measurement instruments, namely, pressure gauges; built-in thermometers; electronic contact thermometers; thermostats; residual flue-gas analyzers; bar code readers; electrical energy utilization metering devices; data loggers for the storage of measurement data regarding physical and chemical properties and parameters; Electronic measuring, signaling and testing devices, namely, ion selective electrodes; orp sensors for measuring a reducing or oxidizing strength of a solution; ionmeters; electronic sensor extension cords and holders; flow-through adapters; analyzers for measuring the content of chemical or biological material in water or waste water, and water filters for use therewith; field monitors for on-site monitoring and analyzing of bod, ph-value, amounts of oxygen and other chemical substrates in liquids; meters, monitors and sensors for measuring oxygen, temperature, ph range and conductivity;

bod sensors for measuring the biological oxygen demand; sensors for determining soil respiration, biodegradation, biogas, determination, anaerobic degradation and microbiology; measurement devices for soil respiration rates; colony counters; photometers; turbidity meters; multiplexers; multiparameter meters for liquid, water and waste water analysis; stirrers, namely, an electrically actuated stirrer for stirring a liquid sample in a test container or having an actuated stirring mechanism coacting with an electromagnetic stirring element through the container wall; thermostating chambers, namely, electrically heated and/or cooled chambers to keep test samples at a desired temperature; electrical sensors; analyzers for nitrate, nitrite, ammonia, ammonium, phosphate, total phosphate and other chemicals comprised in water or waste and for a combined measurement of these parameters; software, printers, connecting cables and measuring stations for measuring devices for measuring bod, temperature, oxygen content and the content of chemical substrates in liquids, especially water and waste water; adapters for connecting sensors to cables and measuring devices; Meters, measuring apparatus, instruments and appliances, namely, pH-meters, conductivity meters, dissolved oxygen meters, redox meters, photometers, spectrophotometers, and multi-parameter meters, namely, combined pH, ion selective electrode (ISE), conductivity and dissolved oxygen (D.O.), oxidation reduction potential (ORP), and T meters; photometer accessories sold as a unit with photometers, namely, cuvettes, vials, optical filters, halogen lamps, paper rolls, cables, cell holders, temperature sensors, stirrers, printers, deuterium lamps, automatic cell changers, sippers, filter sets, thermopacks, quartz cells, flowthrough cells, cylindrical cells and micro cells, glass cells, flowthrough cells, cylindrical cells and micro cells; titrators, piston burettes, sample changers, namely, sample containers for laboratory testing; stirrers for laboratory use, titration vessels, titration tips, titration electrodes, volumetric Karl-Fisher titrators, coulometric Karl-Fisher titrators; instruments for quantitative analytical chemistry, namely, water distillers, titrators, piston burettes, sample changers, stirrers, titration vessels, titration tips, titration electrodes, volumetric Karl-Fisher titrators; coulometric Karl-Fisher titrators; instruments for quantitative analytical chemistry, namely, physical or chemical sensor system for the detection of concentrations of ions and substances in liquids; software for titration which calculates concentrations, storing of titration parameters and maintains a database of titration results and parameters; software for viscosity measuring apparatus, namely, software for controlling of viscosity measuring instruments, calculation of viscosities, storing of measuring parameters and providing a database of measuring results and parameters; software for photometry measuring methods, namely, software for controlling of spectrophotometers, calculation of concentrations, storing of measuring parameters, and providing a database of measuring results and parameters; laboratory apparatus, instruments, and appliances not already listed, namely, pH electrodes, oxygen electrodes, ORP electrodes, conductivity electrodes, laboratory electrodes, temperature sensors; connection cables for use in connection with electrodes; automatic viscosity measurement systems, namely, electronic time-measuring units to determine viscosity; thermostats, viscometers, hotplates for use in laboratories, laboratory stirrers; laboratory measuring instruments, titrators, namely, piston burettes metering system combined with a pH-meter for electrical regulation, and titration vessels in the nature of flasks as parts of titrators; electrical or electronically controlled titration automats, namely, physical or chemical sensor system for the detection of concentrations of ions and substances in liquids; Flow and Level Instrumentation for the Monitoring and Control of Fluids-Namely, Differential Pressure Units, Recorders, Indicators, Switches, Controllers, Transmitters, Meters, Densitometers, Computers, Sealed Sensor Systems Consisting of Assemblies, Tubing and Differential Pressure Units and Analyzers; Boiler Pressure Controls; Pressure Relief Valves for Boilers, Water Tanks and Heaters; Float Actuated Electrical Switches, Flow Switches for Making or Breaking an Electrical Circuit; Liquid Level Controls Used to Guard Against Low or High Levels; Time Delay Relays; solar powered pump system for pumping water, comprised of a solar panel for production of electricity, non-metal garden stake for securing the solar panel, rechargeable battery, submersible pump, pump controller, and plastic intake hose sold as a unit; pump monitoring gauges

Class 011.

All goods and services in the class are opposed, namely: Accumulator tanks for marine vessels, namely, drainage water treatment tanks; waste water purification units; Heat exchangers for general use; special purpose heat exchangers namely, tankless water heaters, heat exchangers for heating water with steam or hot water, hot water storage tank with built in heating coil, water heater for insertion within fluid heating space of a boiler, water heater of the tankless type arranged to trap air in the casing thereof when connected to a closed hot water heating system, converters for transferring heat from steam to water, namely, water heaters, aftercoolers for air and gases, namely, evaporative air coolers, air vents, namely, direct vents for gas appliances, quench tank; self-contained packages,

namely, coolers namely, heat exchangers, expansion tanks, pumps, temperature air separation devices and electrical controls sold as a unit; fuel oil preheaters; Disinfection, decontamination and/or degermination units to neutralize and/or separate harmful substances from liquids, namely, sewage, industrial or other waters, and gases namely, air, and soil, by means of chemical/physical treatment, combined UV light and ozone treatment and/or UV radiation treatment; ozone generators that kill mold and mildew; units to irradiate flowing liquids with UV light; Water filters and waste water purification installations for the treatment, purification, filtration and supply of water and for the treatment of waste water, effluent and sewage; Equipment for filtering municipal, commercial or industrial water and wastewater, namely, plastic filter underdrain blocks, clay filter underdrain blocks, porous plates for supporting media in filters, filter media, gravel for supporting filter media in filters, piping, agitators, supports and stabilizers for piping and agitators, wash troughs, nozzles, effluent troughs, weirs and baffles, weir pans, gates and guides for controlling water flow, valves, specialty filters, pilot filter equipment, blowers and compressors for supplying backwash air to filters, carriage filters, with or without skimmers all sold as a unit; sludge collection equipment for wastewater treatment, namely, floating siphon sludge collectors, skimmers and scum troughs sold as a unit; Equipment for the treatment of wastewater, namely, aeration diffusers, diffuser piping, clarifiers, complete activated sludge processing plants, and structural parts therefore sold as a unit; Wastewater treatment and disposal plants in the nature of activated sludge plants, and structural parts therefor for the treatment of liquid and solid contaminants included in municipal and industrial waste water; lights for marine vessels, namely, search lights, flood lights and docking lights

Class 035.

All goods and services in the class are opposed, namely: Charitable services, namely, promoting public awareness about global water resources, sanitation, sustainability efforts, and related philanthropies

Class 036.

All goods and services in the class are opposed, namely: Philanthropic services concerning monetary donations

Class 037.

All goods and services in the class are opposed, namely: Installation and repair of instrumentation used by others to monitor and control water and wastewater treatment processes, installation and repair of water and wastewater treatment equipment used by others; Installation, repair and maintenance of electronic measuring apparatus, instruments and appliances used for laboratory testing and measurement

Class 040.

All goods and services in the class are opposed, namely: Charitable services in the nature of emergency water treatment


Class 042.

All goods and services in the class are opposed, namely: Instrumentation testing and design services for others, pilot filter testing services for others, and water and wastewater treatment equipment testing and design services for others; Computer programming for others; installation and maintenance of computer software; engineering services; consultation and research in the field of physics; scientific research; technology research in the field of measurement engineering, programming, sensor engineering, computer hardware, and transmitter engineering; technological consultation in the aforementioned fields; technical and scientific surveying; providing project planning services in the field of information and communications networks; product development for others; calibration of measuring instruments; performance testing on measuring instruments; Certifications, namely, testing, analysis and evaluation of goods and services of others for the purpose of certification; industrial analysis and research services for chemical analytics; design and development of computer hardware and software for chemical analytics; installation, repair and maintenance of software

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Prior use, lack of intent to use, unfair competition

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3183362	Application Date	12/05/2005
Registration Date	12/12/2006	Foreign Priority Date	NONE
Word Mark	XYLEM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 011. First use: First Use: 2005/10/01 First Use In Commerce: 2005/10/01 Bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes and lighting fixtures therefor</p> <p>Class 020. First use: First Use: 2005/10/01 First Use In Commerce: 2005/10/01 Bathroom furniture, namely, vanities, shelves, medicine cabinets, countertops, and pedestals</p>		

Attachments	78766777#TMSN.jpeg (1 page)(bytes) 2012-05-01 Notice of Opposition.PDF (12 pages)(663048 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/James M. Slattery/
Name	James M. Slattery
Date	05/01/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Nos. 85/386,849

For the trademark XYLEM (Stylized) in International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42

XYLEM GROUP, LLC.)	
)	
Opposer)	
)	
v.)	Opposition No.
)	
XYLEM IP HOLDINGS LLC.)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, XYLEM GROUP, LLC. (hereinafter “Opposer”) a limited partnership organized under the laws of Georgia, with a principal place of business at 205 Hembree Park Dr., Ste. 130, Roswell, Georgia 30076, respectfully submits that it will be damaged by the issuance of a registration for the mark “XYLEM (Stylized)” (the Applicant’s mark), filed by WATER IP HOLDINGS LLC, a Delaware Corporation, with a place of business at 1209 Orange Street, Wilmington, Delaware 19801, that changed its name to XYLEM IP HOLDINGS, LLC (hereinafter referred to as “Applicant”) a Delaware limited liability company with a place of business at 1209 Orange Street, Wilmington, Delaware 19801. Applicant’s mark was filed on October 20, 2011 as set forth in Application No. 85/386,849, in International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42. Therefore, Opposer files this notice of opposition pursuant to 37 CFR §2.104(b).

1. OPPOSER, its subsidiaries and related companies for many years have manufactured, advertised, sold, and otherwise distributed a wide variety of bathroom and kitchen fixtures, as well as related components under its mark “XYLEM.”

2. Since long before the filing date of Applicant’s ‘849 application at issue and, on information and belief, long before Applicant’s first use of the “XYLEM” mark, Opposer and its subsidiaries and related companies have continuously used the trademark “XYLEM” in commerce in the United States on and in conjunction with the advertising, promotion, sale and distribution of bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely, drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes; and bathroom furniture, namely, vanities, shelves, medicine cabinets, countertops and pedestals and their related components.

3. Opposer owns common law rights in the mark “XYLEM” which have been continuously, prominently, and conspicuously in use on its bathroom and kitchen products, web site and other materials in commerce in the United States since at least as early as October 1, 2005. Said common law trademark includes: “XYLEM” used in connection with bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely, drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes; and bathroom furniture, namely, vanities, shelves, medicine cabinets, countertops and pedestals and their related components.

4. Opposer is the owner of U.S. Registration No. 3,183,362 for the mark “XYLEM” registered on December 12, 2006, used in connection with bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely, drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes; and bathroom furniture, namely, vanities,

shelves, medicine cabinets, countertops and pedestals. A copy of this trademark registration is enclosed as Exhibit 1. A Sections 8 & 15 Declaration was filed on December 12, 2011 and it was accepted by the USPTO on February 1, 2012, in connection with the goods set forth in the Opposer's registered mark. To date, this trademark registration is still valid and in full force and effect.

5. The Opposer's mark "XYLEM" is a famous mark through use of the mark for more than five years in connection with the goods set forth in the Opposer's registered mark in commerce within the United States and Opposer's mark has gained a good reputation among its customers.

6. The Opposer's mark is inherently distinctive.

7. Opposer itself and through its subsidiaries and related companies have shipped and sold several million dollars' worth of bathroom and kitchen products and related components, under its "XYLEM" mark and has spent substantial sums in advertising and promoting the trademark.

8. On August 2, 2011, Applicant filed a trademark application for the mark "XYLEM (Stylized)" in connection with goods in the International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42. This application corresponds to Serial No. 85/386,849, which was published for opposition on April 10, 2012.

9. Applicant's mark "XYLEM" is likely to be confused with and mistaken for Opposer's marks "XYLEM" for bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely, drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes; and bathroom furniture, namely, vanities, shelves, medicine cabinets,

countertops and pedestals and their related components as sold under the “XYLEM” mark because Applicant’s mark is confusingly similar in sight, sound and commercial impression to Opposer’s “XYLEM” marks. Applicant’s and Opposer’s marks are exactly the same.

10. Applicant’s mark is intended for use in connection with products in International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42, that overlap with and are related to Opposer’s products marketed and sold under the “XYLEM” marks. Applicant currently has not claimed use of the mark “XYLEM” on and in connection with goods in International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42.

11. Applicant’s targeted customer base overlaps with the customers of Opposer’s bathroom and kitchen related products, marketed and sold under the “XYLEM” marks in the plumbing industry since the Applicant’s goods set forth in the opposed application do not have any restrictions or limitations of use or field. Additionally, Applicant’s goods are predominantly used in the plumbing industry which directly overlaps and includes many of Opposer’s customers.

12. As Applicant’s goods description contains no restrictions or limitations as to Applicant’s channels of trade, Opposer may assume that Applicant’s mark, like Opposer’s own mark will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant’s intended channels of trade for its products overlap with the channels of trade used by Opposer in marketing, selling, and otherwise distributing its products under the “XYLEM” marks.

13. Opposer is neither affiliated nor connected with Applicant or its goods; nor has Opposer endorsed or sponsored Applicant or any of its goods.

14. There is no issue as to priority of use. Opposer began using its “XYLEM” mark at least as early as October 1, 2005, and enjoys priority well prior to Applicant’s first use of the “XYLEM” mark.

FIRST GROUND FOR OPPOSITION:

LIKELIHOOD OF CONFUSION

15. Opposer incorporates by reference paragraphs 1 to 14, inclusive, as if fully set forth herein.

16. Applicant’s mark is identical to Opposer’s mark in appearance, pronunciation and trade connotation.

17. Applicant’s mark is intended for use in connection with products that overlap with and are related to Opposer’s products marketed and sold under the “XYLEM” marks.

18. Opposer is not affiliated or connected with Applicant or its goods, nor has Opposer endorsed or sponsored Applicant or its goods.

19. Applicant’s targeted customer base overlaps with the customers of Opposer’s products marketed and sold under the “XYLEM” marks.

20. Applicant’s intended channels of trade for its products offered under the “XYLEM” mark overlap with the channels of trade used by Opposer’s in marketing, selling, and otherwise distributing its products marketed and sold under the “XYLEM” marks.

21. If Applicant is permitted to register Applicant’s mark for the goods specified in the application in International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42, as herein opposed, confusion resulting in damage and injury to Opposer would likely occur. Persons familiar with Opposer’s marks would likely perceive Applicant’s products as associated, affiliated with, or

sponsored by Opposer. Such confusion would result in damage to Opposer. Actual confusion has already occurred through use of the opposed mark by Applicant's alter ego.

22. Opposer's customers and the relevant public are likely to missassociate Applicant's mark as Opposer's trademark rather than a trademark by Applicant and/or believe in error that goods offered under the Applicant's "XYLEM" mark are offered by, in association with, or under license from Opposer.

23. Applicant's use and intended use of the mark in International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42, as shown in Application Serial No. 85/386,849 ("XYLEM") is without Opposer's consent or permission.

24. Any defect, objection to, or fault found with Applicant's products marketed under its "XYLEM" mark would necessarily reflect on and seriously injure the reputation that Opposer has established for its bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely, drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes; and bathroom furniture, namely, vanities, shelves, medicine cabinets, countertops and pedestals and their related components marketed and sold under the "XYLEM" mark.

25. Registration of Applicant's mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's mark and of Applicant's exclusive rights to use its "XYLEM" mark, all to the detriment of Opposer.

26. Registration of the mark herein opposed will damage Opposer because Applicant's "XYLEM" mark is likely, when used on or in connection with the goods described in the opposed application, to cause confusion, or to cause mistake, or to deceive. Thus, the

“XYLEM” mark is unregistrable under Section 2(d) and 3 of the Trademark Act, as amended, 15 USA §§ 1052(d) and 1053, and should be refused registration.

SECOND GROUND FOR OPPOSITION:

PRIOR USE

27. Opposer has used its marks since at least as early as October 1, 2005 for bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely, drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes; and bathroom furniture, namely, vanities, shelves, medicine cabinets, countertops and pedestals and their related components in the United States.

28. On December 5, 2005, Opposer filed a trademark application to protect the mark “XYLEM” based on use of the mark.

29. There is no issue as to priority of use since Opposer began using the mark “XYLEM” and enjoyed priority as a result of using the mark, well prior to the filing date of the Applicant’s application.

THIRD GROUND FOR OPPOSITION:

LACK OF INTENT TO USE

30. Applicant is a holding corporation with no ability or intent to use any trademark. Applicant filed trademark Application No. 85/386,849, on August 2, 2011, stating that “Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services” in the trademark application.

31. Applicant lacked a good faith intent to use the mark in commerce in connection with the goods as set forth in Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42, in the '849 application, when said trademark application was filed in the USPTO.

32. Accordingly, Applicant's mark is unregistrable pursuant to Sections 2(a)(d), 3, 13, and 43(e) of the United States Trademark Act, as amended, 15 USC §§ 1052(a)(d), 1053, 1063, 1125, and should be refused registration.

FOURTH GROUND FOR OPPOSITION:

INTENT TO COMMIT FRAUD

33. When Applicant filed the application on August 2, 2011, Applicant stated "To the best of his/her knowledge and belief, no other person, firm, corporation or associate has the right to use the mark in commerce, either in the identical form thereof, or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." Applicant had intent to commit fraud because Applicant's alter ego received a Cease and Desist letter before the date of filing of the opposed application.

34. During the prosecution, in Applicant's Response to Office Action filed on November 23, 2011, while the Applicant argued that its goods "toilets for marine vessels" are quite different from the goods set forth in the Opposer's trademark Registration No. 3,183,362 for the mark "XYLEM," in that the respective goods are in different channels of trade and sold to different customers. However, Applicant intentionally deleted the term "toilets for marine vessels" but did not delete any other goods set forth in the opposed application for marine

vessels. Applicant's statements in the Response to Office Action were fraudulently made with the intent to deceive the USPTO since Applicant knew that the other goods and services which were not deleted from the opposed application actually did not have restrictions or limitations with respect to fields of use but had the same customer base and were sold in the same channels of trade as compared to the Opposer's goods.

35. The Examining Attorney relied on the statements of the Applicant set forth in the Applicant's original application and believed that Applicant had no knowledge of the Opposer's mark at the time of filing the opposed application.

36. The Trademark Examining Attorney relied on the Applicant's statements set forth in its Response to the Office Action and believed that the Applicant's goods set forth in the opposed application are different while the Applicant actually did not limit or restrict the other undeleted goods in the opposed application.

37. The Trademark Examining Attorney relied on the false statements made by Applicant as set forth above and approved the opposed application for publication.

FIFTH GROUND FOR OPPOSITION:

DILUTION

38. Even if Applicant's opposed application was filed based on a bona fide intention to use the mark in commerce, the use of the mark by Applicant's alter ego in connection with the goods set forth in the opposed application has and will continue to dilute the strength and reputation of the Opposer's mark.

SIXTH GROUND FOR OPPOSITION:

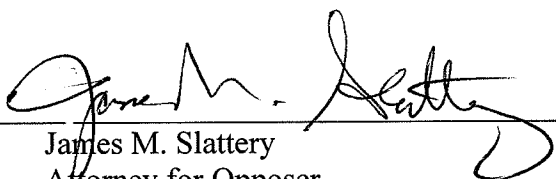
UNFAIR COMPETITION

39. Applicant falsely designated its origin by adopting "Xylem" in its trade name when the Applicant changed Water IP Holdings LLP to Xylem IP Holdings LLC on October 10, 2011, when the Applicant does not have any connection with the Opposer and had no permission from the Opposer to use the trade name Xylem IP Holdings LLC to the detriment of the Opposer since the relevant public would believe that Applicant's corporation was affiliated with the Opposer's corporation. It would be likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of the Applicant's corporation with the Opposer's corporation with the relevant public being deceived to believe that the Applicant's corporation had the same origin and had the sponsorship approval of the Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that Application No. 85/386,849 be denied and refused registration.

Dated: May 1, 2012

Respectfully submitted,

By 
James M. Slattery
Attorney for Opposer
BIRCH STEWART KOLASCH & BIRCH, LLP
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Falls Church, VA. 22042
Tel: 703-205-8000
Fax: 703-205-8050
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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing NOTICE OF OPPOSITION has been served on the attorneys for the Applicant:

Jason K. Schmitz
BAKER & MCKENZIE LLP
130 E. Randolph Street, Suite 3500
Chicago, IL. 60601-6342

by first class mail, postage prepaid, and email, on this 1st day of May, 2012.

By Tiffany C. Johnson.

Int. Cls.: 11 and 20

Prior U.S. Cls.: 2, 13, 21, 22, 23, 25, 31, 32, 34 and 50

Reg. No. 3,183,362

United States Patent and Trademark Office

Registered Dec. 12, 2006

**TRADEMARK
PRINCIPAL REGISTER**

XYLEM

XYLEM GROUP, LLC (GEORGIA LIMITED
PARTNERSHIP)

430 GUNSTON HALL DRIVE

ALPHARETTA, GA 30004

FOR: BATHROOM AND KITCHEN FIXTURES,
NAMELY, SINKS, FAUCETS, PLUMBING FIT-
TINGS, NAMELY DRAINS, BATH DRAINS, LAVA-
TORY DRAINS, VESSEL MOUNTING RINGS, SINK
STOPS AND SINK RISER TUBES AND LIGHTING
FIXTURES THEREFOR, IN CLASS 11 (U.S. CLS. 13,
21, 23, 31 AND 34).

FIRST USE 10-1-2005; IN COMMERCE 10-1-2005.

FOR: BATHROOM FURNITURE, NAMELY, VA-
NITIES, SHELVES, MEDICINE CABINETS, COUN-
TERTOPS, AND PEDESTALS, IN CLASS 20 (U.S.
CLS. 2, 13, 22, 25, 32 AND 50).

FIRST USE 10-1-2005; IN COMMERCE 10-1-2005.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

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KRISTIN DAHLING, EXAMINING ATTORNEY